

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599



ATTORNEY DOCKET NO. 10030215-1

AFU

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): James M. Minor

Serial No.: 10/821,829

Examiner: Showronek, Karlheinz R.

Filing Date: April 9, 2004

Group Art Unit: 1631

Title: Methods and Systems for Evaluation and for Comparing Methods of Testing Tissue Samples

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☐ No additional fee (Address envelope to "Mail Stop Amendments")
☐ Other: (Fee \$_____)

| CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY | | | | | | |
|---|--|--|---|---|-------------|---------------------------|
| (1) FOR | (2) CLAIMS REMAINING AFTER AMENDMENT | (3) NUMBER EXTRA | (4) HIGHEST NUMBER PREVIOUSLY PAID FOR | (5) PRESENT EXTRA | (6) RATE | (7) ADDITIONAL FEES |
| TOTAL CLAIMS | | MINUS | | = 0 | X 50 | \$ 0 |
| INDEP. CLAIMS | | MINUS | | = 0 | X 200 | \$ 0 |
| <input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM | | | | | + 360 | \$ 0 |
| EXTENSION FEE | 1 ST MONTH 120.00 <input type="checkbox"/> | 2 ND MONTH 450.00 <input type="checkbox"/> | 3 RD MONTH 1020.00 <input type="checkbox"/> | 4 TH MONTH 1590.00 <input type="checkbox"/> | | \$ 0 |
| OTHER FEES | | | | | | \$ 0 |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | | | \$ 0 |

Charge \$0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.2 5. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

James M. Minor

By

Alan W. Cannon for John Brady
Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: 6/12/2006

Typed Name: Maria J. Sousa

Signature:

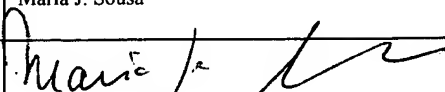
Reg. No. 34,977

Date: 6/12/06

Telephone No. (408) 736-3554

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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| | | | |
|-----------------------|---|------|-----------|
| Typed or Printed Name | Maria J. Sousa | | |
| Signature |  | Date | 6/12/2006 |

| | | |
|---|----------------------------------|--|
| RESPONSE TO RESTRICTION REQUIREMENT Address to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | Attorney Docket Confirmation No. | 10030215-1 1398 |
| | First Named Inventor | Minor |
| | Application Number | 10/821,829 |
| | Filing Date | 04/09/2004 |
| | Group Art Unit | 1631 |
| | Examiner Name | Skowronek, Karlheinz R. |
| | Title | Methods and Systems for Evaluation and for Comparing Methods of Testing Tissue Samples |

Sir:

This is in response to the Restriction Requirement dated May 26, 2006, for which a one-month period for response was given making this response due on or before June 26, 2006.

THE RESTRICTION REQUIREMENT

In the Official Action dated May 26, 2006, the Examiner required an election of one of the following "inventions" that the Examiner identified:

"Group I" – drawn to a rank ordering method (claims 1-13 and 17-20);

"Group II" – drawn to a "data shuttling method" (claims 14-16);

"Group III" – drawn to a calibration method (claims 21-27); and

"Group IV" – drawn to a method of distinguishing genes (claims 28-33).

The Examiner required election of one of the above-listed Groups I-IV to be responsive to the Office Action.

RESPONSE

In response to the restriction requirement, Applicants elect Group I, claims 1-13 and 17-20, with traverse. Since claims 14-16 are limited to forwarding, transmitting or receiving data produced by the method of claim 1, it is respectfully submitted that these claims should be examined together with claims 1-3 and 17-20, since the data required for transmission, forwarding or receiving must be

produced by the method of claim 1, and search required for Group I would also be required for Group II. Applicant respectfully submits that it would not be an undue burden upon the Office to examine the claims of Group I and Group II in the instant application together in this case.

Conclusion

Applicant respectfully submits that a proper response has been made to the Restriction Requirement., and that all of the claims in this application are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

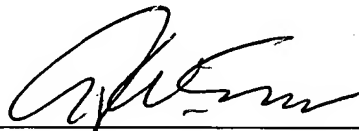
The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030215-1.

Respectfully submitted,
LAW OFFICE OF ALAN W. CANNON

Date: _____

6/12/06

By: _____



Alan W. Cannon for John Brady
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